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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,194	10/19/2001	Christoph Heckenkamp	BEU/HECK3001	7979
23364	7590	12/18/2003	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			ASSAF, FAYEZ G	
			ART UNIT	PAPER NUMBER
			2872	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,194

Applicant(s)

HECKENKAMP ET AL.

Examiner

Fayez G. Assaf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-18, 20-32, 34-42, 49-64, 66, 67 and 77 is/are pending in the application.
- 4a) Of the above claim(s) 36-42, 60-64, 66 and 67 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-26, 34, 35 and 49-59 is/are allowed.
- 6) ☒ Claim(s) 8-18, 20, 21, 27-32 and 77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 09/023,430.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

The status of the claims now is as follows:

Claims 8-18, 20-32, 34-42, 49-64, 66, 67 and 77 are pending.

Claims 36-42 and 60-64, 66 and 67 are still withdrawn from consideration.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-18, 20, 21, 27-32 and 77 are rejected under 35 U.S.C. 102(b) as being anticipated by Watanabe et al. (US 5,344,808).

Watanabe discloses a data carrier (see Fig.'s 12 and 15) which is manufactured and thereafter issued for use, the data carrier having a body provided with a multiplayer, optically variable element comprising metal diffraction structures (14 of

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Fig. 12) having a contour and being common to a plurality of data carriers, the diffraction structures presenting visually recognizable information (line 58 to line 59 of Col. 27), wherein the data carrier is provided with an alteration in a portion of the optically variable element, the alteration comprising a modification of the contour of the diffraction structures (300 of Fig. 12; 400 of Fig. 15). The alteration comprises replacing the diffractive structure of the contour in at least one partial area (see Fig. 12). The data carrier is provided with printed pattern (see Fig. 12C), said printed pattern being at least partially overlapped by the optically variable element, wherein the printed pattern being visible through the diffraction structures (see Fig. 12).

Regarding claims 14 and 16, Watanabe discloses the data carrier comprising a metal layer of colored appearance or one layer being colored (line 40 to line 57 of Col. 11).

Regarding claims 17 and 20, Watanabe discloses the layer of the variable element being colored with a substance comprising dyes, luminescent substances, transparent luminescent substances or absorbent substances and the printed pattern being a transparent luminescent (line 54 of Col. 13 to line 28 of Col. 14, claim 6).

***Allowable Subject Matter***

Claims 22-26, 34, 35 and 49-59 are allowed.

Claims 22 and 23 are allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the alteration comprising replacing the diffraction structures by nondiffractive structures in at least one partial area as set forth in the claimed combination.

Claims 24-26, 34, 35 and 49-59 are allowable over the prior art for at least the reason that the prior art fails to teach or reasonably suggest the alteration comprising a partial removal of at least one layer of the optically variable element as set forth in the claimed combination.

***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fayez G. Assaf whose telephone number is (703) 306-5526. The examiner can normally be reached on 8-5 M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Fayez G. Assaf  
Examiner  
Art Unit 2872

*Fayez Assaf*

FA  
12/15/03